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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,581	02/23/2004	Michael D. Kotzin	CS24447RA	9640
20280	7590	02/29/2008	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			JEFFERSON, DEAUNDRE L	
			ART UNIT	PAPER NUMBER
			4157	
			NOTIFICATION DATE	DELIVERY MODE
			02/29/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/784,581	<b>Applicant(s)</b> KOTZIN, MICHAEL D.	
	<b>Examiner</b> DEAUNDRE JEFFERSON	<b>Art Unit</b> 4157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/23/2004, 06/09/2005</u> .                                  | 6) <input type="checkbox"/> Other: ____.                          |

**Detailed Office Action**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 17 contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to identify the phrases “content unit” and “second media data”. Also, the way the claim is written is inconsistent with claims 1 and 9.

For purposes of art rejection it is assumed that claim 17 is consistent with claims 1 and 9.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-17 are rejected under 35 U.S.C. 102(b) as being unpatentable by  
US Pub. No. 2002/0092019 (Marcus hereinafter).

Marcus teaches:

A method of a client device for presenting customized media streams  
comprising:

receiving a first media content (receiver collects media from first media source-  
see [0029]) and a first media data (markers-see [0148]) associated with the first  
media content from a remote server (media streaming servers- [0146]) wherein  
the first media data indicates at least one insertion point of the first media content  
(delivered programs has markers indicating appropriate points of insertion of  
additional programming material –see [0148]); retrieving a second media content  
from a local memory of the client device (receiver inserts from memory  
replacement element - [0214]); and providing a combined media to an output  
device, wherein the combined media includes the first media content and at least  
a portion of the second media content inserted at the at least one insertion point  
of the first media content (the assembled program is displayed- see [0029]).

Re claim 2, the method of claim 1, further comprising:

receiving the second media content from a remote device (secondary content is  
received from a third party server – see [0148]) before receiving the first media  
content and first media data (second media content programming can arrive  
anytime prior to insertion into main program- see [0148]-[0149]) and storing the

second media content at the local memory (background programming, considered to be secondary content, is saved-[0136]).

Re claim 3, the method of claim 1, wherein providing a combined media to an output device includes providing the combined media to at least one of visual output device and an audio output device (combined program is displayed -see [0029]).

Re claim 4, the method of claim 1, wherein the first media data indicates an insertion length corresponding to each insertion point of the at least one insertion point of the first media content ( Although art is silent about insertion length it is inherent that the first media data (tags) include insertion length because such information would have to be known second media provider in order to insert content with appropriate length into the programming).

Re claim 5, the method of claim 4, wherein:  
receiving a first media content and a first media data associated with the first media content from a remote server includes receiving the first media data before receiving the first media content (receiver is able to receive untagged media content and tag the contents itself once the media content is received – [0033], thus it is inherent that the tags (first media data) are received before first media content) ; and the second media content is retrieved from the local memory in response to receiving the first media data and irrespective of receiving the first media content (advertising elements have the ability to deploy themselves independent of any streamed programming-[0101]).

Re claim 6, The method of claim 1, further comprising selecting a particular portion of the second media content from a plurality of portions of the second media content (receiver selects media elements from media streams for inclusion in the program- see [0038]).

Re claim 7, the method of claim 6, further comprising identifying portions of the second media content having an appropriate length for insertion into a particular insertion point of the first media content (Tags address the selection of appropriate content by defining the size and length of present media- see [0396] and [0399]).

Re Claim 8, the method of claim 1, further comprising communicating billing information to a remote billing center in response to providing the combined media to the output device (receiver has ability to return a record of programming consumed and or billing information to providers- see [0297]).

For Claim 9, Marcus teaches:

A wireless communication device (cell phone- see [0135]) for presenting customized media streams comprising:

a transceiver (cell phone inherently has transceiver) configured to receive a first media content and a first media data associated with the first media content from a remote server, wherein the first media data indicates at least one insertion point of the first media content (delivered programs has markers indicating appropriate points of insertion of additional programming material –see [0148]); a processor (cell phone inherently has processor), coupled

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to the transceiver, configured to retrieve a second media content from a local memory of the client device (see [0141]) ; and an output device, coupled to the processor, configured to provide a combined media including the first media content and at least a portion of the second media content inserted at the at least one insertion point of the first media content (the assembled program is displayed- see [0029]).

Claim 10 is rejected w/r to claim 2.

Re claim 11, the wireless communication device of claim 9, wherein the output device is at least one of a visual output device and an audio output device (display-130 see fig 1).

Claim 12 is rejected with w/r to claims 4 and claim 9.

Claim 13 is rejected w/r to claims 5 and 9

Claim 14 is rejected w/r to claims 6 and 9.

Claim 15 is rejected w/r to claims 7 and 14.

Claim 16 is rejected w/r to claims as claim 8 and 9.

Re Claim 17, a method of a wireless communication system for supporting a remote device to present customized media streams comprising:  
transmitting a **second media content** to the remote device (receiver is connected to a second media source-[0029]), the **second media content** including at least one content unit configured to be inserted into another media content (tags allow elements of second media content to be selected [0038]); and transmitting a **first media content** and a **first media data** associated with the first media content to the remote device after transmitting the **second media**

**content** to the remote device (second media content programming can arrive anytime prior to insertion into main program- see [0148]-[0149]), wherein the first media data indicates at least one insertion point of the first media content to receive the at least one content unit of the second media content (delivered programs has markers indicating appropriate points of insertion of additional programming material –see [0148]).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2003/0056010 Kaars.

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deaundre Jefferson whose telephone number is (571)-270-3754 examiner can normally be reached on Mon-Thurs from 7:30am-5:00pm and Fri from 7:30am-10:00am.If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more



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information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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